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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,658	02/15/2002	Marc Husemann	tesa AG 1525-WCG	2957
27386	7590	05/03/2004	EXAMINER	
WILLIAM GERSTENZANG NORRIS, MCLAUGHLIN & MARCUS, P.A. 220 EAST 42ND STREET, 30TH FLOOR NEW YORK, NY 10017			COLE, ELIZABETH M	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/077,658	Applicant(s) HUSEMANN ET AL.	
	Examiner Elizabeth M. Cole	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 19807752 to Harder et al, (equivalent to U.S. Patent No. 6,432,529). Harder does not disclose the outgassing level. However, since Harder discloses the same composition and further teaches that the adhesive is low in fogging, (i.e., low outgassing level), presumably, Harder et al's adhesive would inherently possess the claimed outgassing level.

3. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harder et al, DE 19807752, (equivalent to US 6,432,529) in view of Harder et al, DE 4313008, (equivalent to Harder et al, U.S. Patent No. 6,613,870). Harder et al '752 discloses an acrylic pressure sensitive adhesive and an adhesive tape comprising the adhesive as set forth above, as set forth above. Harder et al differs from the claimed invention because Harder et al does not disclose the claimed method of making the adhesive and the tape. Harder '008 teaches that acrylic adhesive compositions may be formed by free-radical polymerization. An entrainer may be employed to further concentrate the polymerizate. The polymer may be extruded. See col. 2, line 16 – col. 3, line 27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the method set forth by Harder '008 to make the adhesive of Harder '752. One of ordinary skill in would have been motivated to employ the method of Harder '008 because both references teach acrylic pressure sensitive adhesive compositions and

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Harder '008 teaches that the disclosed method produces various advantages over prior art processes. See col. 2, lines 31-46. With regard to the particulars of the UV light which is used to crosslink the acrylic pressure sensitive adhesive, since Harder '752 teaches crosslinking the polymer with UV light, it would have been obvious to one of ordinary skill in the art to have employed the particular frequency of light which would crosslink the polymer.

4. Applicant's arguments filed 3/1/04 have been fully considered but they are not persuasive. Applicant argues that there is nothing in the '752 reference that would teach or suggest the claimed outgassing level. However, the claim recites that the adhesive composition is based at least predominantly on (meth)acrylic acid, claim 2, recites particular monomers, claim 9 recites a backing tape comprising the composition of either claims 1 or 2 and claim 10 recites an outgassing tendency of the tape of claim 9. Harder discloses the claimed adhesive composition and discloses its use as the adhesive portion of an adhesive tape. Harder teaches that adhesive is "non-fogging". The rejection was set forth under 102/103 because the examiner is unable to determine whether or not the Harder adhesive has the claimed properties. "When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02. The basis for shifting the burden to applicant is found in the disclosure of the same adhesive composition as that claimed, as well as in the disclosure of the adhesive being non-fogging. Therefore, the rejection has been maintained. With regard to claims 1-2 and 9-10, Applicant also argues that the low outgassing level is

achieved through particular process steps such as the use of an entrainer. However, none of these limitations are found in claims 1-2, and 9-10.

With regard to the rejection of claims 1-13, Applicant argues that Harder '008 teaches that his composition have proportions of volatile substances of 0.8% which is far in excess of the claimed outgassing level. However, Harder '088 is not relied on for the teaching of being non-fogging or having a particular outgassing level, but instead is relied on to show that the claimed method of making the adhesive composition was known.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c